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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/764,071

01/23/2004

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8003

7590
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New York, NY 10017

01/16/2008

EXAMINER

REESE, DAVID C

ART UNIT

PAPER NUMBER

3677

MAIL DATE

DELIVERY MODE

01/16/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/764,071

Applicant(s)

KEJEJIAN, TOROS

Examiner

David C. Reese

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

THIS FINAL ACTION IS RESPONSIVE TO THE AMENDMENT FILED 10/9/2007.

- Claims 1-20 were canceled.
- Claims 21-40 are pending.

Priority

[1] The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 29/179069, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. In the instant case, changing the priority from a continuation application to a continuation in part application will remedy said deficiency.

Claim Objections

[2] Claim(s) 21, 23, 30, and 35 were previously objected to because of informalities. Applicant has successfully addressed these issues in the amendment filed on 10/9/2007. Accordingly, the objection(s) to the claim(s) 21, 23, 30, and 35 have been withdrawn.

Claim Rejections - 35 USC § 102

[3] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[4] Claim 21 is rejected under 35 U.S.C. 102(e(1)) as being unpatentable over Abaev, US-D499, 981, because the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

The shape and appearance of Abaev is identical in all material respects to that of the claimed design, *Hupp v. Siroflex of America Inc.*, 122 F.3d 1456, 43 USPQ2d 1887 (Fed. Cir. 1997).

As for Claim 1, Abaev teaches of a mixed cut gemstone comprising:

a brilliant cut crown;

a step cut pavilion (see figure below);

four lower corner facets (1), said lower corner facets being triangles (1);

two long-side lower girdle facets (2), said long-side lower girdle facets being triangles or trapezoids (2);

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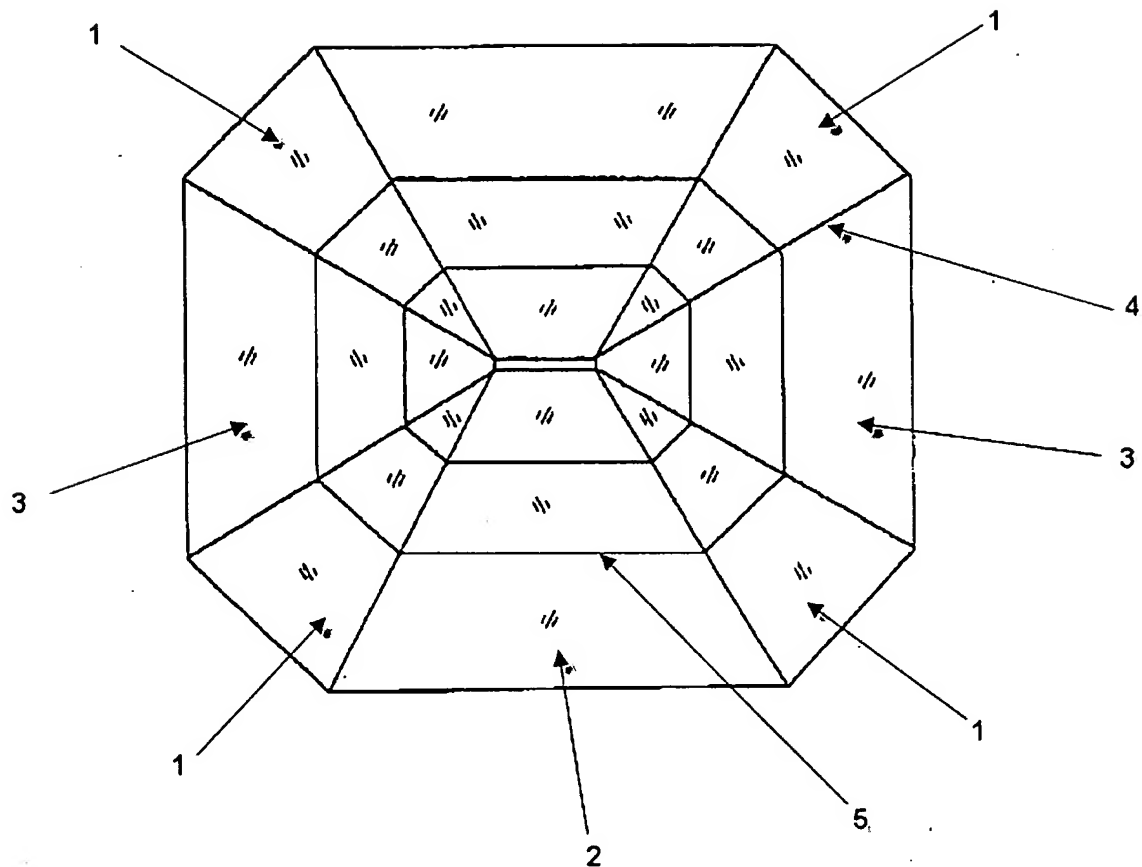
two short-side lower girdle facets (3), said short-side lower girdle facets being triangles (3);

a plurality of step cuts (5), said step cuts being substantially equal in width; and

a plurality of rib lines (4);

whereby said step cuts (5) are cut at a predetermined angle with respect to said lower girdle facets (2,3) with each step (5) being at a slightly different angle, said different angle step cuts (5) [allowing light that passes through the crown to hit the plurality of step cuts at different angles thereby bending the light several times in different directions thus providing the gemstone with parallel incoming and outgoing rays of light that make the gemstone appear more brilliant and scintillated].

Examiner's note: the above statement in brackets is an example of intended use. Note that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham, 2 USPQ2d 1647 (1987)*. In the instant case, the above amendment to the claim has provided no additional structure requirements or limitations. Attempting to claim a gemstone via the way light passes through said gemstone is not proper and is not given any patentable weight over the prior art that satisfies the same structural limitations.



Claim Rejections - 35 USC § 103

[5] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

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skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[6] Claims 22-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abaev, US-D499, 981, in view of Kejajian US-6,449,985.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 22, Abaev teaches of that from Claim 21.

The difference between the claim and Abaev is that the claim recites:

four upper corner facets, said upper corner facets being polygons;

two long-side upper girdle facets, said long-side girdle facets being triangles;

two-short side upper girdle facets, said short-side upper girdle facets being triangles; and

four break table lines, said break table lines separating said table from said upper corner facets;

[whereby said break table lines provide the gemstone with better dispersion and scintillation coefficients].

Kejajian discloses a mixed cut gemstone similar to that of Abaev. In addition, Kejajian further teaches a

a girdle (51);

a table (13);

four upper corner facets (15), said upper corner facets being polygons (15);

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two long-side upper girdle facets (17), said long-side girdle facets being triangles (17);
two-short side upper girdle facets (17), said short-side upper girdle facets being triangles
(17); and

four break table lines, said break table lines separating said table (13) from said upper
corner facets (15);

[whereby said break table lines provide the gemstone with better dispersion and
scintillation coefficients].

[]: Example of intended use as the statement fails to further limit the structure of the
claimed invention. Note that it has been held that a recitation with respect to the manner in
which a claimed apparatus is intended to be employed does not differentiate the claimed
apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte*
Masham, 2 USPQ2d 1647 (1987).

It would have been obvious to one of ordinary skill in the art, having the disclosures of
Abaev and Kejejian before him at the time the invention was made, to modify the crown and
table of Abaev to incorporate an embodiment (with obvious sizes changes to accompany the
different size pavilion, as in Kejejian). One would have been motivated to make such a
combination because one would want to achieve that crown and table structure, as taught by
Kejejian to go along with the pavilion structure from Abaev.

Re: Claim 23, Kejejian (Claim 1).

Re: Claim 24, Kejejian discloses wherein the table (13) is flat.

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Re: Claim 25, Abaev teaches wherein said lower corner facets have an inclination of approximately 40 to 50 degrees with respect to a plane of said girdle (the figures of the pavilion between the applicant and Abaev are identical).

Re: Claim 26, Abaev teaches wherein said lower corner facets (1) are isosceles triangles (1).

Re: Claim 27, Kejejian (Claim 5).

Re: Claim 28, Kejejian (Claim 6).

Re: Claim 29, Kejejian (Claim 11).

Re: Claim 30, Kejejian (Claim 12).

Re: Claim 31, Abaev teaches wherein said rib lines divide said pavilion into eight sides.

Re: Claim 32, Abaev teaches wherein said rib lines run from said girdle's eight sided shape to a culet line.

Re: Claim 33, Abaev teaches wherein said rib lines converge at a culet point.

Re: Claim 34, Kejejian discloses wherein said table is slightly elevated from the surface of a girdle plane.

Re: Claim 35, Kejejian (Claim 12).

Re: Claim 36, Kejejian (Claim 11).

Re: Claim 37, Abaev teaches wherein said pavilion has a depth of approximately one fourth of a length of said girdle (the figures of the pavilion between the applicant and Abaev are identical).

[7] Claims 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abaev, US-D499, 981, in view of Kejejian US-6,449,985, and further in view of Grossbard, US -4,555,916.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 38, Abaev in view of Kejejian teaches of claim 22.

The difference between the claim and Abaev in view of Kejejian is the claim recites: further comprising a plurality of crown facets. Grossbard discloses a mixed cut gemstone similar to that of Abaev in view of Kejejian. In addition, Grossbard further teaches of a plurality of crown facets (19). It would have been obvious to one of ordinary skill in the art, having the disclosures of Abaev in view of Kejejian and Grossbard before him at the time the invention was made, to modify the crown of Abaev in view of Kejejian to include facets as in Grossbard. One would have been motivated to make such a combination because one would want to achieve that exact crown facet structure, as taught by Grossbard.

Response to Arguments

[8] Applicant's amendment, see amendment and remarks filed 10/9/2007, with respect to the rejection(s) of claim(s) have been fully considered but are not persuasive. Applicant argues that the prior art does not teach of having a brilliant cut crown or a step cut pavilion. The examiner disagrees. In the instant claims, the structure as provided to such terms as "brilliant" are those that are stated explicitly in the claims, such as the number, location, and size of facets of said brilliant cut for example. But since characteristics of the facets comprising the "brilliant" cut have been claimed in 22, with no additional structure in the claim afforded to the "brilliance" of

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the crown, the examiner maintains that the prior art as applied above is proper with respect to the current claim listing. Further, with respect to the use of the term, "step cut pavilion", the examiner disagrees with applicant that Abaev does not disclose of such a feature. As shown above, Abaev does indeed disclose of a pavilion having step cuts (5). Further, even if the term, "brilliant" and "step-cut" were further defined in the specification, which may or may not be the case, the applicant misinterprets the principle that claims are interpreted in the light of the specification. Although these elements are found as examples of embodiments in the specification, they were not claimed explicitly. Nor were the words that are used in the claims defined in the specification to require these limitations. A reading of the specification provides no evidence to indicate that these limitations must be imported into the claims to give meaning to disputed terms. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064.

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Conclusion

[9] **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

[10] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30-6:00 Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached at 571-272-7075. The fax number for the organization where this application or proceeding is assigned is the following: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DCR



David Reese
Assistant Examiner
Art Unit 3677

